

Claim 4 remains rejected under 35 USC 102(a) as allegedly being anticipated by WO 01/48100, and Claim 5 remains rejected under 35 USC 103(a) as allegedly being unpatentable over WO 01/48100 in view of EP 892024. The Examiner advises that an English translation of the priority document is not found in the file. Applicants submit the English translation herewith.

Applicants respectfully note that the cited primary reference, WO 01/48100, was filed after November 29, 2000 and was not published in English under PCT Article 21(2) such that it has no 35 U.S.C. 102 (e) prior art date. See MPEP 706.01(f)(1). Accordingly, the reference is only citable as of its PCT publication date of July 5, 2001, which is **after** the filing dates of Applicants' Japanese priority applications. Accordingly, the English translation of the earlier priority application overcomes the reference. See MPEP 201.15.

The claims stand rejected under 35 USC 103(a) as allegedly being unpatentable over Nguyen et al in view of Sano et al or over this combination of references further in view of EP 892024. Applicants respectfully traverse these rejections.

The claimed invention requires that the recited sulfonyl group-containing (co)polymer is present in the claimed ink composition in the form of an emulsion. This feature is not shown or suggested in the cited references.

The Examiner considers Nguyen at column 22, lines 39-42 to show this claim

limitation. At column 22, lines 39-42, Nguyen discloses that the primer or additive, core/shell polymer (II), can be prepared by a bulk polymerization process which can provide a polymer solution or by an emulsion polymerization process which can provide a polymer suspension. However, this disclosure does not show that the core/shell polymers should be present in Nguyen's **ink compositions** in the form of an emulsion; it merely provides the preparation process of the polymer. It is not apparent from this disclosure what form the polymer takes in the ink composition of Nguyen.

In fact, the disclosure in Nguyen at column 22, line 31 *et seq.* (i.e., "both core/shell polymers disperse the pigment or dye in the ink-jet . . .") would suggest to one of skill in the art that the polymer bonds to the pigment or dye and thus should **not** be present in an ink composition in the form of an emulsion.

In short, Applicants respectfully submit that the passage in the reference to which the Examiner refers cannot be relied upon to show or suggest the subject claim limitation. Accordingly, and in the absence of anything in the cited references to show or suggest this limitation, Applicants respectfully submit that the USPTO has not satisfied its initial burden of factually supporting a *prima facie* conclusion of obviousness. See MPEP 2142.

In view of the above, Applicants respectfully submit that all rejections and objections of record have been overcome and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,

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